

REMARKS

In response to the Office Action dated February 27, 2004, claim 5 has been canceled and claims 1, 6, 10, 11, 12, 17 and 20 have been amended. Claims 1-4 and 6-23 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action stated that the Oath/Declaration was missing the date and the number of the application and that correction was required.

The Applicant traverses this statement and submits that correction is not required because the originally filed Oath/Declaration contained a proper signature of the inventor along with the execution date and did not need to have the number of the application since it was identified with the current application, which was filed concurrently with the Oath/Declaration. 35 U.S.C. § 115. 37 CFR 1.63. MPEP 602 et seq.

The Office Action rejected claims 1, 2, 4, 6, 7, 10, 20, 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. (U.S. Publication No. US2002/0071559) in view of Nunley et al. (U.S. Patent No. 4,404,649) and further in view of Blumenthal et al. (U.S. Patent No. 5,784,460). The Office Action rejected claims 3 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Nunley et al. and further in view of Blumenthal et al. and further in view of Chan et al. (U.S. Patent No. 6,378,070). The Office Action rejected claims 5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Nunley et al. and further in view of Blumenthal et al. and further in view of Allen (U.S. Patent No. 6,041,316). The Office Action rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Nunley et al. and further in view of Blumenthal et al. and further in view of Sansone et al. (U.S. Patent No. 6,373,587). The Office Action rejected claims 12, 13, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Rosenberg et al. (U.S. Patent No. 6,363,357). The Office Action rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Rosenberg and further in view of Sansone. Last, the Office Action rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Christensen et al. in view of Rosenberg and further in view of Sansone and further in view of Blumenthal et al.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant's claimed invention includes decrypting at the printer a first portion of the partially encrypted file, printing at least a second portion of the partially encrypted file using a serialized print methodology that includes having the printer generate a unique serialized print number for the document file in the course of printing the document file and printing at least a portion of the decrypted document file using a guaranteed print methodology that includes sending the first computer information about the number of printed pages and output print quality of the document file.

In contrast, the references, in combination or alone, do **not** disclose, teach or suggest all of these elements. Specifically, although the Examiner used Christensen et al. as his main reference to show encryption and decryption of electronic data, this reference **cannot** be used for this reason because Christensen et al., does **not** disclose, teach the Applicant's decrypting at the printer a first portion of the partially encrypted file.

Instead, the computer in Christensen et al. first fully decrypts the document and then transmits the fully decrypted document to the printer. This is very different from the present invention because decryption at the computer, like Christensen et al., allows an unscrupulous user to modify the printer driver, for example, by changing the printer driver name. In this case, the unscrupulous user can electronically capture the print job and redistribute it easily. In many cases, printer drivers are represented and differentiated by their device context, which is stored in the registry, and can easily be shared via a registry file. This fraudulent action cannot be performed with the present invention because decrypting is done at the printer.

Next, although the Examiner used Nunley et al. as a reference to show serialized printing, this reference does **not** disclose, teach or suggest the Applicant's serialized print methodology. This is because Nunley et al., does **not** disclose, teach or suggest having the printer generate a unique serialized print number for the document file in the course of printing the document file and using a guaranteed print methodology that includes sending the first computer information about the number of printed pages and output print quality of the document file. Instead, Nunley et al. uses a pre written SICN on the original document to support data entry and **not** a unique serialized print number for the document file in the

course of printing the document file, like the Applicant's claimed invention. Nunley et al. is using the SICN merely to produce a customer reference for getting data entry information for the record in question.

Moreover, even when the other cited references, namely, Blumenthal et al., Chan et al., Allen, Sansone et al. and Rosenberg, are combined with Christensen et al. and Nunley et al., they still don't produce the Applicant's decrypting at the printer, having the printer generate a unique serialized print number for the document file in the course of printing the document file and using a guaranteed print methodology that includes sending the first computer information about the number of printed pages and output print quality of the document file.

It is well settled that all of the claimed elements of an Applicant's invention **must be considered**. (*In re Kotzab*, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP* 2143.). If **one** of the elements of the Applicant's invention is missing from or not taught in the cited references and the Applicant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP* 2143.03). The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Consequently, obviousness cannot be established by combining these references. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). This **failure** of the cited references, either alone or in combination, to disclose, suggest or teach all of the elements of the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (*MPEP* 2143).

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (*MPEP* § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the

Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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